

III. REMARKS

Status of the Claims

Claims 1 and 9-13 are amended. Claims 1-7, and 9-16 are presented for further consideration.

Summary of the Office Action

Claims 1, 7, and 13 stand rejected under 35USC102(a) on the basis of the cited reference Murphy, U.S. Patent No. 6,667,738. Claims 2-6, and 14 stand rejected under 35USC103(a) on the basis of the cited reference Murphy in view of the reference Nakimi Corporation. Claim 9-12 stand rejected under 35USC103(a) on the basis of the cited reference Murphy in view of the reference Chikano, WO/00/21155. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks. Claims 15 and 16 are indicated to be allowable if written in independent form.

Applicant has amended the claims to clarify the novel features of the invention for which protection is sought in this application. These amendments are submitted after final rejection in order to place the claims in condition for allowance or, in the alternative, to place the claims in better condition for appeal. The Examiner is requested to exercise his discretion and enter these amendments.

In rejecting the claims, the examiner has cited, for the first time, the reference Murphy as a basis for the anticipation and obviousness rejections. The citation of this new reference was not necessitated by Applicant's prior amendments and accordingly the issuing of final rejection is improper under MPEP section 706.07(c) where it is stated:

"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant, who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."

The Examiner is respectfully requested to reconsider the final nature of the pending office action and his rejection in view of the above amendments and the following arguments. The entering of the above amendments will permit the clarification of the issues for appeal or the allowance of the claims.

Discussion of the Cited References

The Examiner has cited the reference Murphy in support of the rejection based on anticipation. In the device of Murphy a flexible membrane is mounted for movement into operative engagement with a touch sensitive screen. The membrane retracts into a slot that is located below the screen. In one embodiment, figure 4, a pair of sprockets with a series of projections engage each side of the membrane to propel the membrane into a position over the screen. The sprockets may be driven by an electric motor.

The flexible membrane of Murphy is not the same as the cover element of the subject application. It will not serve to protect the screen, except perhaps from dust, but certainly not from mechanical damage. The membrane of Murphy must be flexible in order to be used with the touch sensitive screen and for it to retract.

In addition, according to the claims as amended, both the

user interface and the cover element of the subject device are moveable and the converting means is operatively associated with each, to move the cover element in the opposite direction from the user interface. This feature does not form part of the device in the reference Murphy.

The Examiner is reminded that the anticipation analysis requires a positive answer to the question of whether the device of Murphy would infringe the claims of this application if it were later.

Claim 1 of this application is directed to a device that has:

"converting means operatively associated with said interface and said cover element for converting the rotational movement into a movement of the first cover element and said interface between the first position and the second position on a surface of the user interface, wherein said cover element moves opposite to said interface."

Since this feature is not present in the system of the reference Murphy, there can be no infringement of the claim 1. Equivalent language is also present in claim 13 and this argument applies equally to dependent claim 7. Therefore the teaching of Murphy does not support the rejection based on anticipation with respect to any of the claims.

In the rejection of claims 2-6, and 14 the Examiner characterizes the reference Murphy as follows:

"Murphy differs from the claimed invention in that it does not explicitly mention type of motor, such as motor having an epicycle gear, and the first and second angular speeds."

This ignores the other points of differentiation between the device of Murphy and that claimed in this application described

by applicant above. The lack of a cover element and converting means that move both cover element and user interface are more significant than the type of motor. The reference to Namiki cited by the Examiner, only suggests a type of motor, it does not provide any incite into how a Namiki motor would be combined with the flexible membrane of Murphy to obtain the moveable protective cover element of this application. The reference Namiki does not remedy the deficiencies of Murphy. The combination of Murphy and Namiki, therefore, does not support the rejection of claims 2-6 and 14 based on obviousness.

The Examiner further seeks to combine the reference Murphy with the teaching of Chikano in support of the rejection of claims 9-12 based on obviousness. The Examiner refers to the second embodiment of Chikano shown in figure 4. In this embodiment, the device of Chikano comprises a mechanism by which an antenna may be extended by the operation of a rotatable cover. The cover 6a is connected to a slidable rack 9a that drives a pinion gear 15a. Pinion gear 15a drives another pinion gear 14a that in turn drives slider 8a. Movement of slider 8a extends the antenna. The flexible membrane of Murphy would be ill served by the complex drive mechanism of Chikano. The Examiner has characterized the combined teaching as follows:

"Murphy differs from the claimed invention in that it does not move a second moveable element. However, Chikano teaches providing a motor(7) which moves a first cover element (9a,6a) and a second moveable antenna element (8a,3a) and in opposite directions (see 8a and 9a)"

This is a substantial contortion of the teaching of Chikano. First there is no motor in the second embodiment to which the Examiner refers, only the pair of rack and pinion elements 7a that is driven by the operation of cover 6a. Second, although the sliders 8a and 9a do move in opposite directions, the antenna

moves up and down while the cover is rotated and these are presented by the Examiner as the analogous elements. The reference Chikano does not support the Examiner's characterization.


The Applicant submits that there is no reason presented as to why a person skilled in the art would be encouraged to combine the teachings as suggested by the Examiner.

According to the basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the references must be viewed without the benefit of hindsight. (See MPEP sections 706.02(a) and 2141. Applicant submits that the modification of the teachings of Murphy and Namiki or of Murphy and Chikano, in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art. There is no indication that such modifications would be desirable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

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Respectfully submitted,


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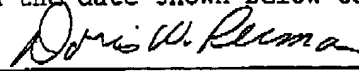
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